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cont.

monoalcohols having a global solubility parameter according to the Hansen solubility space of less than or equal to 20 (MPa)^{1/2}.--

Remarks

I. Status of the Claims

Claims 1-56 and 59 are pending in this application. Claim 44 has been amended to more remove the bullets, as requested by the Examiner. Accordingly, this amendment in no way narrows the scope of the amended claim, nor does it add new matter.

II. Rejections under Obviousness-Type Double Patenting Rejection

Claims 1-59 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-60 of co-pending Application No. 09/880,792 and claims 1-39 of co-pending Application No. 09/880,787.

Although Applicants disagree with all of these rejections, in an effort to advance prosecution, they submit herewith a Terminal Disclaimer to render the rejections moot. Accordingly, Applicants respectfully request the withdrawal of these rejections.

III. Claim objection

Claim 44 has been objected to because of the use of bullets. Accordingly, Applicants have amended claim 44 to remove the bullets, thus rendering this objection moot.

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IV. Claim rejection under § 102(e)

Claims 1-18, 20-31, and 46-56 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,264,933 to *Bodelin et al.* ("*Bodelin*"). Applicants respectfully traverse this rejection.

A rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. See *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); see also M.P.E.P. § 706.02(a).

In the present case, *Bodelin* is drawn to a cosmetic composition for coating keratin fibers which can provide a waterproof coating that curls the keratin fibers. See e.g., Abstract. *Bodelin*'s compositions comprise "an aqueous phase dispersed in a liquid fatty phase that contains at least one volatile organic solvent, the aqueous phase containing a polymer system comprising at least one film-forming polymer, characterized in that the film-forming polymer is in the form of solid particles dispersed in the aqueous phase, and in that the composition also comprises at least one lamellar filler." See col. 1, lines 57-63. Further, *Bodelin*'s compositions may optionally further comprise a number of optional ingredients, including waxes. See col. 7, line 8-col. 9, line 30.

The Examiner asserts that "[p]olyethylene waxes having a melting point of 45-70°C will inherently act as thermal transition agents." See page 4 of the present Office Action. The Examiner also asserts that "the recited film resistance to hot and cold

water...are inherent in the reference because the reference teaches the same film-forming and thermal transition agents employed as [sic] the same amounts as claimed in the instant claims." *Id.* Thus, the Examiner's rejection is based on inherency.

According to the Federal Circuit, to establish inherency, the extrinsic evidence "must make **clear** that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by the persons of ordinary skill." See *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (emphasis added). In the present case, it is **not** clear that the compositions of *Bodelin* will **necessarily** be capable, at the temperature of the keratinous material, of forming a film having resistance (R_c) to hot water maintained at 40°C, of less than or equal to 15 minutes, and a resistance (R_f) to cold water, maintained at 20°C such that $R_f - R_c \geq 8$ minutes.

The Examiner's reasoning also directly contradicts the teachings of the M.P.E.P. The M.P.E.P. § 2112 makes clear that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic—the result or characteristic must necessarily be present in the prior art (citing *In re Rijckaert* 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). Further, inherency may not be established by probabilities or possibilities. *Id.* The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.* "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent

characteristic necessarily flows from the teachings of the applied prior art." *Id.* (emphasis in original).

First, *Bodelin* asserts that certain of the disclosed compositions are waterproof. See e.g., Abstract, col. 1, line 48, and Examples 1 and 4. Further, *Bodelin*'s disclosure of waxes shows that the presently claimed characteristics of the composition would not necessarily be present in the compositions of *Bodelin*. For example, *Bodelin* discloses optional waxes at col. 7 through col. 8. Specifically, *Bodelin*'s compositions can comprise at least one wax (Ia) with a melting point of greater than or equal to 70°C and less than 83°C and/or at least one wax (Ib) with a melting point ranging from 83°C to 110°C. See col. 7, lines 38-41. *Bodelin*'s compositions can also comprise at least one wax (II) which has a melting point of greater than or equal to 45°C and less than 70°C. See col. 7, lines 54-56. In fact, *Bodelin* states that "[a]dvantageously, [both] the wax (I) and the wax (II) can be present in the composition" in certain ratios and exemplifies compositions comprising at least one wax (Ia), at least one wax (Ib), and at least one wax (II). See col. 8, lines 10-13 and Examples 1-4.

However, Applicants have shown that Comparative Example 12 comprising a polyethylene wax with a melting point of 83.9°C does not, at the temperature of the keratinous material, form a film having resistance (Rc) to hot water maintained at 40°C, of less than or equal to 15 minutes, and a resistance (Rf) to cold water, maintained at 20°C such that $R_f - R_c \geq 8$ minutes as presently claimed. Accordingly, *Bodelin*'s compositions are not necessarily and inevitably capable, at the temperature of the keratinous material, of forming a film having resistance (Rc) to hot water maintained at

40°C, of less than or equal to 15 minutes, and a resistance (Rf) to cold water, maintained at 20°C such that $R_f - R_c \geq 8$ minutes as presently claimed.

For at least the foregoing reasons, Applicants respectfully request that this rejection be withdrawn.

V. Claim Rejections Under 35 U.S.C. § 103

Bodelin in view of Simon and Mougin

Claims 32-45 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bodelin* in view of U.S. Patent No. 6,333,053 to *Simon* ("*Simon*") and U.S. Patent No. 5,851,517 to *Mougin et al.* ("*Mougin*") for the reasons set forth on page 5 of the present Office Action. Applicants respectfully traverses this rejection.

To establish a prima facie case of obviousness, an Examiner must meet three basic criteria. First, she must demonstrate that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. Second, an Examiner must demonstrate that there was a reasonable expectation of success. Finally, the prior art reference(s) must also teach or suggest all the claim limitations. See M.P.E.P. § 2143. In the present case, none of these criteria has been satisfied.

As discussed above, *Bodelin* does not teach each and every element of the presently claimed compositions. For example, *Bodelin* does not teach compositions which are capable, at the temperature of the keratinous material, of forming a film having resistance (Rc) to hot water maintained at 40°C, of less than or equal to 15

minutes, and a resistance (Rf) to cold water, maintained at 20°C such that $R_f - R_c \geq 8$ minutes. The Examiner's reliance on *Simon* and *Mougin* for the teaching of aqueous and nonaqueous dispersion of polymer particles does not cure the aforementioned deficiencies of *Bodelin*.

Further, *Bodelin* itself does not suggest the claimed properties. "To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir, 2000). Even when obviousness is based on a single prior art reference, there must be a such showing. See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996). In the present case, the Examiner has not provided any motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicants, nor of the claimed properties. In contrast, the Examiner merely states that these would be inherent. See rejection under §102(e) at page 4 of the present Office Action. However, Applicants have shown that the claimed properties are not necessarily present in *Bodelin*'s compositions and thus the rejection cannot be based on inherency.

Finally, as discussed above, *Bodelin* teaches that its compositions may be waterproof and each of the compositions exemplified in *Bodelin* comprises at least one wax with a melting point of greater than or equal to 70°C and less than 83°C and at least one wax (Ib) with a melting point ranging from 83°C to 110°C.

Thus, for at least the foregoing reasons, Applicants submit that the combination of the cited references does not provide the requisite suggestion or motivation to modify *Bodelin* or to combine the reference teachings and does not teach or suggest all the claim limitations, and that there would not have been a reasonable expectation of success. Accordingly, Applicants respectfully request withdrawal of this rejection.

Bodelin

Claim 59 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bodelin* for the reasons set forth on pages 5-6 of the present Office Action. Applicants respectfully traverses this rejection for at least the same reasons discussed above with respect to the rejection under § 102(e) and the rejection under § 103(a) over *Bodelin* in view of *Simon* and *Mougin*.

Specifically, the Examiner's conclusory statement that "it would be conventional and within the skill of the art to identify the optimal concentration of emulsifier in order to achieve the desired cosmetic effect and/or stability of the composition" is not only a legally insufficient basis for rejection under § 103 under the current standard recently affirmed in the Federal Circuit (see *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002)), but also fails to cure *Bodelin*'s aforementioned deficiencies.

Thus, for at least the foregoing reasons, Applicants respectfully request withdrawal of this rejection.

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VI. Conclusion

In view of the foregoing amendment and remarks, Applicants respectfully request the reconsideration of the pending claims and reexamination of the application. The timely allowance of the pending claims is respectfully requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

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Dated: January 10, 2003

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Appendix

Version with markings to show changes made pursuant to 37 C.F.R. § 1.121(c)(1)(ii):

IN THE CLAIMS:

--44. (Amended) A composition according to claim 32, wherein the liquid fatty phase is at least one compound chosen from:

[-] non-aqueous liquid compounds having a global solubility parameter according to the Hansen solubility space of less than $17 \text{ (MPa)}^{1/2}$, and

[-] monoalcohols having a global solubility parameter according to the Hansen solubility space of less than or equal to $20 \text{ (MPa)}^{1/2}$.--